

**REMARKS**

The present invention is directed to a very specific product, in particular, it is directed to a dual sided album leaf having a first ply layer and a second ply layer each having an outer surface and an inner surface. The first and second ply layers are secured together so as to form a pocket there between. In addition, the outer surface of the first and/or second ply layer have a plurality of images formed thereon. Claim 1 further includes an insert having a side configuration such that it can be placed within the pocket and has information thereon that relates to the plurality of images. In addition, the information on the insert is located in a position on the insert such that it can be readily identified with respect to which of the plurality of images it is associated. Applicants respectfully submit that the Fountain reference does not teach or suggest the invention as set forth by Applicants.

In response to Applicants arguments presented in the previous response, the Examiner states that the Fountain reference is cited for disclosing an image placed on an insert. The Examiner then goes on to state "it would have been obvious to one having ordinary skill in the art at the time the invention was made to include as many images as desired, since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art." The Examiner then cites *St. Regis Paper Co. v. Bemis Co.* for support in fact that mere duplication of the essential working parts of a device involves only routine skill in the art and therefore it would have been obvious to include as many images as desired.

However, the Examiner has failed to identify the essential working parts of Fountain. Is it the fact that there is an image placed in an insert? Therefore, if such is the case, the mere providing of multiple inserts or inserts and holders would be obvious. However, that is not what the present invention is directed to. The present invention is directed to providing a plurality of images on the album leaf. This is not taught or suggested by Fountain, nor is there any suggestion to do so. Furthermore, the present invention provides that information is provided on the insert and is located in a position such that the information can be readily identified with respect to which of the plurality of images is associated. In the present invention, the fact that there are a plurality of images requires that

the information provided can be readily related to its associated image. Since the Fountain reference does not disclose more than one image, it could not address the problem to which the present invention is directed, that is, providing of information with respect to more than one image on an insert and associating that information so that it can be readily identified with respect to the image it is associated, therefore, providing the appropriate information with respect to its associated image. The CAFC stated in *In Re Lee* 277 Fed 3<sup>rd</sup> 1330 (61 USPQ 2<sup>nd</sup> 1430) 2002 "the factual inquiry whether to combine references must be thorough and searching. It must be based on objective evidence of record." The court at 1443 stated "(our case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references)". The Court goes on to state "(there must be some motivation, suggestion, or teaching of the desirability of making the specific combination that was made by the applicant)". The Court at 1443 stated "only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references".

In the present situation, the Fountain reference does not teach or suggest providing multiple images or associating specific information with each of the plurality of images. The Examiner merely relies on the fact that in the Examiner's opinion it would be obvious to modify and provide as many images as desired. Even if one were to put more than one image, there is still no teaching or suggestion of providing information in a location such that it can be readily identified with respect to which of the plurality of images it is associated. Thus, the Examiner has failed to show:

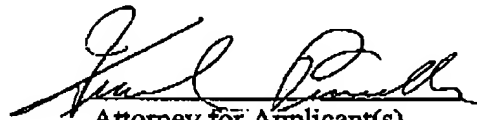
- 1) motivation to modify or provide more than one image;
- 2) providing information for each image at a location such that the information can be readily identified with respect to which image it is associated.

The Examiner states correctly that when printed matter is not functional it will not distinguish the invention from the prior art in terms of patentability. In this regard, Applicants have clearly demonstrated the functionality of the information provided. The present invention does not simply

claim printed matter, it claims that the printed matter is located at a position such that it can be readily identified with respect to which of the plurality of images it is associated. This is a functional relationship between the printed matter on the insert and the particular image it is associated therewith on the album leaf. The printed matter has a location on the insert that gives it functionality. The Examiner appears to argue that printed matter (such as size, dimension) is not the kind of functionality necessary for patentability. However, it is not mere size of the print to which the functionality of the printed matter in the present invention applies, it is the location of the various informations on the insert and its relationship to the images that provides the functional relationship.

In view of the foregoing, Applicants respectfully submit that the claims in their present form are in condition for allowance and such action is respectfully requested.

Respectfully submitted,

  
Attorney for Applicant(s)  
Registration No. 27,370

Frank Pincelli/phw  
Rochester, NY 14650  
Telephone: 585-588-2728  
Facsimile: 585-477-4646